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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,465	04/16/2004	Joseph E. Kaminkow	112300-2205	1481

7590
Bell Boyd & Lloyd LLC
P.O. Box 1135
Chicago, IL 60690
05/16/2007

EXAMINER

SAX, STEVEN PAUL

ART UNIT	PAPER NUMBER
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2174

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/826,465	Applicant(s) KAMINKOW ET AL	
	Examiner Steven P. Sax	Art Unit 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-39 and 73-78 is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 13-17, 21, 25-30, 40-44, 52-56, 60, 64-69, 79, 81-83 and 87 is/are rejected.
- 7) ☒ Claim(s) 6-8, 10-12, 18-20, 22-24, 31-33, 45-51, 57-59, 61-63, 70-72, 80 and 84-86 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been examined. The Terminal Disclaimer filed 3/2/07 has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 9, 13-17, 21, 25-30, 40-44, 52-56, 60, 64-69, 79 are rejected under 35 U.S.C. 102(e) as being anticipated by Cole et al (6612574).

4. Regarding claim 1, Cole et al show: a gaming device operated under the control of a processor, said gaming device comprising:

a game controlled by the processor and operable upon a wager by a player; a plurality of reels in the game; a plurality of symbols on the reels (abstract, Figures 1-2, column 2 lines 9-40 and 47-55),

(a) said symbols including a first designated symbol at a designated position on said reels, said first designated symbol displayed as first indicia or as different second indicia

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at said designated position on the reels (column 3 lines 50-67, column 4 lines 1-37), and

(b) said symbols including a second designated symbol at a different designated position on said reels, said second designated symbol displayed as first indicia or as different second indicia at said designated position on the reels (column 4 lines 45-60, column 5 lines 50-65, column 6 lines 7-32),

wherein each of said designated symbols has a function on the reels in the game for determining any winning outcomes; an input device operable with the processor to enable the player to select which of the first indicia or the second indicia of the first designated symbol will be displayed at the designated position of said first designated symbol on said reels (again column 6 lines 10-35 and note the bonus reel), wherein:

(a) if the player inputs a selection of the first indicia of the first designated symbol on the reels to be displayed at the designated position of said first designated symbol on said reels, the processor causes: (i) the first indicia of said first designated symbol to be displayed at said designated position of said first designated symbol on the reels, and (ii) the first indicia of the second designated symbol to be displayed at said designated position of said second designated symbol on the reels (column 6 lines 35-55, column 7 lines 5-30 and 40-55), and (b) if the player inputs a selection of the second indicia of the first designated symbol on the reels to be displayed at the designated position of said first designated symbol on said reels, the processor causes: (i) the second indicia of said first designated symbol to be displayed at said designated position of said first designated symbol on the reels, and (ii) the second indicia of the second designated symbol to be displayed at said designated position of said second designated symbol

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on the reels (column 7 lines 40-66, column 8 lines 1-12, column 10 lines 11-26 and 32-59); and at least one winning outcome adapted to be provided to the player based on the symbols generated on said reels and said functions of said symbols regardless of which of said indicia is displayed at the designated position of said designated symbol (column 6 lines 10-35, column 10 lines 40-60).

5. Regarding claim 2, the input device includes a touch screen (column 7 lines 33-40).

6. Regarding claim 3, the first designated symbol and the second designated symbols are on the same reel (column 7 lines 39-59 for example).

7. Regarding claim 4, the first designated symbol and the second designated symbols are on different reels (column 6 lines 20-45, column 7 lines 39-59).

8. Regarding claim 5, the first designated symbol and the second designated symbols are the same symbol (column 6 line 20-45 and column 7 lines 39-59).

9. Regarding claim 9, the first designated symbol and the second designated symbol are different symbols (column 6 lines 5-15 and 20-45).

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10. Claims 13-17 and 21 show the same features as claims 1-5 and 9 and are rejected form the same reasons.

11. Claims 25-30 show the same features as claims 1-5 and 9 and are rejected for the same reasons.

12. Claims 40-44 show the same features as claims 1-5 and are rejected for the same reasons.

13. Claims 52-56 and 60 show the same features as claims 1-5 and 9 and are rejected for the same reasons.

14. Claims 64-69 show the same features as claims 1-5 and 9 and are rejected for the same reasons.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. Claims 79, 81-83 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole et al (6612574) and Walker et al (6561903).

17. Regarding claims 79, 81-83, in addition to that mentioned for claims 1 and 3-5, note that Cole et al do not go into the details of the remote server, but do mention a variety of data sources for the gaming device for efficient transmission of data. Furthermore, Walker et al do show using a server as a data source for the gaming device, for efficient transmission of data (abstract, column 3 lines 25-50). It would have been obvious to a person with ordinary skill in the art to have this in Cole et al, because it would provide an efficient transmission of data.

16. Regarding claim 87, the server causes many of the functions, including causing the display of symbols (Walker et al column 3 lines 20-50 for example). The obviousness to have this in Cole et al follows the same reasoning as that given in paragraph 17 of this Office Action.

17. Claim 87 is objected to because of the following informalities: It should depend off of claim 79, not claim 1. It appears to be a typographic error. Appropriate correction is required.

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18. Claims 6-8,10-12,18-20,22-24,31-33,45-51,57-59,61-63,70-72,80 and 84-86 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. These claims bring out the detailed gaming and indicia functionalities, which in combination with the other features are not set forth in the prior art of record.

19. Claims 34-39 and 73-78 are allowable over the prior art of record. These claims bring out the detailed gaming and indicia functionalities, which in combination with the other features are not set forth in the prior art of record.


20. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. But note that the Double Patenting rejection has been removed in view of the Terminal Disclaimer.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven P. Sax whose telephone number is (571) 272-4072. The examiner can normally be reached on Monday thru Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



STEVEN GAY
PRIMARY EXAMINER